



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,773	11/17/2003	Fatih M. Uckun	12152.0076USC2	8890

7590 01/30/2007
Attention of Anna Nelson
Merchant & Gould
P.O. Box 2903
Minneapolis, MN 55402-0903

EXAMINER

TRUONG, TAMTHOM NGO

ART UNIT	PAPER NUMBER
----------	--------------

1624

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/30/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/715,773

Applicant(s)

UCKUN ET AL.

Examiner

Tamthom N. Truong

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10-25-06 (Election).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,13,17,18,20-26 and 30-43 is/are pending in the application.
- 4a) Of the above claim(s) 20-26 and 30-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,13,17 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/4 + 3/31/05 + 2/27/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's election of Group I (Claims 1,13, 17 and 18 (in part)) is acknowledged.

Claims 2-12, 14-16, 19 and 27-29 are cancelled.

Claims 30-43 have been added.

Newly submitted claims 30-43 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: They are directed to different methods of use.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 30-43 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claims 20-26 are withdrawn as being drawn to the non-elected subject matter.

Only claims 1, 13, 17 and 18 are considered herein.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 1624

1. Claims 1, 13 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by **Uckun et. al.** (US 6,080,747). In columns 19 and 20, Table 1 lists several 6,7-dimethoxy-4(substituted aniline)-quinazoline compounds that read on the instant formula I (recited in the instant claims 1 and 13) with the following substituents:

- i. R₁, R₅, R₆, R₇ and R₈ – each is hydrogen;
- ii. R₂ is either hydrogen or halogen;
- iii. R₃ is either hydrogen or hydroxy;
- iv. R₄ is hydrogen, hydroxy or halogen;
- v. R₉ and R₁₀ – each is methoxy;

Note, the compound excluded from the instant claim 1 is recited in the instant claim 17, and is disclosed as compound VHI-P131 in Table 1 of US'747.

2. Claims 1, 13 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by **Goodman et. al.** (J. Biol. Chem., 7/10/98, Vol. 273, No. 28, pp. 17742-48): On page 17743, the compound of *4-(3'-bromo-4'-hydroxyphenyl)-amino-6,7-dimethoxyquinazoline* reads on the instant formula I with the following substituents:

- i. R₁, R₄, R₅, R₆, R₇ and R₈ – each is hydrogen;
- ii. R₂ is halogen;
- iii. R₃ is hydroxy;
- iv. R₉ and R₁₀ – each is methoxy;

The disclosed compound is a JAK inhibitor, and is used to treat lymphoma.

3. Claims 1 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by the following references:

- a. **Kubo et. al.** (Bioorg. & Med. Chem., 1997, Vol. 7, No. 23, pp. 2935-40): For example, see compounds 9b and 9d on page 2938.
- b. **Coe et. al.** (WO 92/14716): For example, see the 3rd and 5th compounds on page 22.
- c. **Foster** (US 3,985,749): For example, see compound #5 in Table 1 (columns 3 & 4).
- d. **Kobayashi et. al.** (US 4,322,420): For example, see the compounds in Examples 1 and 2 (column 8).

The above compounds read on the instant formula I with the following substituents:

- i. R_1 - R_8 – each is hydrogen, alkyl, halogen or alkoxy;
- ii. R_9 and R_{10} – each is hydrogen, or alkoxy.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamthom N. Truong whose telephone number is 571-272-0676. The examiner can normally be reached on M, T and Th (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

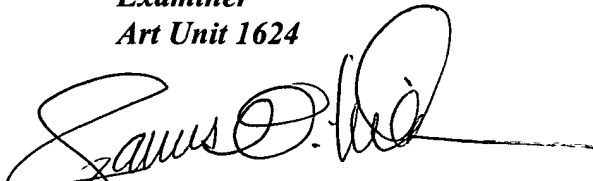
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Art Unit: 1624

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Tamthom N. Truong
Examiner
Art Unit 1624

1-18-07


JAMES O. WILSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600